

Remarks

In the parent case, the Examiner's rejection of claims 1-14 was appealed under 35 U.S.C. § 134. In a Decision On Appeal (the "Decision"), the Board Of Patent Appeals And Interferences (the "Board") affirmed the Examiner's final rejection of claims 1-14. The Examiner rejected claims 1, 5, and 10-14 under 35 U.S.C. § 103 as being unpatentable over Pastan (U.S. Pat. No. 5,635,599) in view of Lin (U.S. Pat. No. 4,703,008). The Examiner further rejected claims 1-4 and 6-9 under 35 U.S.C. § 103 as being unpatentable over Pastan (U.S. Pat. No. 5,635,599) in view of Lin (U.S. Pat. No. 4,703,008), Chaudhary (*Nature*, Vol. 339, pp. 394-396 (1989)) and Cousens et al. (U.S. Pat. No. 4,751,180).

In upholding the Examiner's rejection of independent claim 1, the Board decided that it would have been *prima facie* obviousness at the time of the invention to apply Pastan in view of Lin to circularly permute a human EPO polypeptide at positions 25, 27, 30, 32, 80, 82, 88, 116 and 121. In footnote 1, the Board stated:

We recognize that appellants' claim 1 identifies more than these nine sites, however, given that the claim is written in Markush format the combination of references only has to suggest the modification at one of these sites. **Here all nine amino acid positions identified by the examiner are identical to nine of the positions identified by the appellants.**

Decision on Appeal, August 13, 2003, at 4 (emphasis added).

Regarding the Examiner's 103 (a) rejection of claims 2-4 and 6-9, the Board further stated:

[H]aving found that the examiner properly established a *prima facie* case of obviousness for claim 1 over the combination of Pastan and Lin, and that claim 1 does not require a linker sequence different than that disclosed by Pastan . . . , we affirm the rejection of claim 1 . . . as being unpatentable over Pastan in view of Lin, Chaudhary and Cousens. As set forth *supra*, 2-4 and 6-9 **fall together with claim 1.**

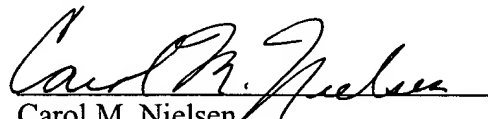
Id. at 9 (emphasis added).

Applicants have amended independent claim 1 by removing the breakpoints at positions 25, 27, 30, 32, 80, 82, 88, 116 and 121 as disclosed by Lin. Applicants respectfully submit that this application and all pending claims are now in a condition for allowance.

This Amendment does not increase the number of independent claims, does not increase the total number of claims, and does not present any multiple dependent claims. Accordingly, no fee based on the number or type of claims is currently due. Applicants hereby authorize the Commissioner to charge any underpayment of fees that may be required by this paper to Deposit Account No. 07-0153.

Respectfully submitted,

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